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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,934

Applicant(s)

WRIGHT, CARL A.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's response to restriction requirement, paper #5, received on 3/25/2004 is acknowledged. Claims 8-11 and 21-23 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Applicant's election without traverse of claims 1-7 and 12-20 in Paper No. 5 is acknowledged. Currently claims 1-7 and 12-20 are pending for examination

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9, 11-23 and 26-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2.1. Claimed Invention(s) does not fall within the Technological Art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or

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composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not

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on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, **State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed**

invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1-17 may have no connection to the technological arts. None of the steps necessarily indicate any connection to a computer or technology. The step of selecting clients, defining bill format, collecting data, correlating collected data with specific fields in the bill format, defining a bill format as a closing or duplicate or corrected bill and displaying a bill image on a display device could be performed manually by people. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim 1 contains subject matter, " selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill ", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation " The method of claim 1, wherein the correlated data ", There is insufficient antecedent basis for this limitation in the claim 1 on which the claim 2 is dependent. Since claim 4 is a dependency of claim 3 it will also inherit the same deficiency.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 13, 16-17, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. 9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 1, Ensel discloses a method for providing particularized billing services, the method comprising the steps of:

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selecting a client for whom a bill is to be produced (see at least col.4, lines 16-38, wherein Ensel discloses presenting bills to the consumer as per the format specified by the customer. In order to present the bill to the consumer, as per the consumer specified format, the step of selecting that consumer will be inherent. See also col.8, lines 14-25, which discloses presenting bills to customers 80 and it would be inherent to select customers for presenting the bill as per the customer specified format);

extracting a list of software objects, each having a predefined bill format with specific fields for the selected client or clients in the market segment to which the client belongs (see at least col.8, lines 14-25, which disclose a list of software objects such as generating a regular paper mail 25, or E-mail 30 or a biller direct presentation site 35 and so on as per the selection of the customer. See also col.10, line 21-col.14, line 53);

invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format; and producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields (see at least col.4, lines 17-39, "
..... In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP. Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP ". Note: In Ensel, retrieving the billing data, formatting

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the bill format, as specified by the consumer, and presenting the bill to the consumer corresponds to the claimed limitation of invoking a software object to collect data and producing the bill with the collected data in appropriate fields. As regards appropriate fields, please see col.10, line 21-col.11, line 5 which describes an E-bill file 215 varying from biller to biller and includes fields such as , customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. See also col.10, line 21-col.14, line 53).

Regarding claim 2, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one specific field in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as , customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53) .

Regarding claims 3-4, please note that they have been rejected under second paragraph of 35 U.S.C. 112 as being indefinite. Ensel, does show that the correlated data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into different portions of the bills (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information).

Regarding claim 5, Ensel discloses that the method of claim 1, further comprising the steps of generating separate images from the collected data and correlating the separate images to at least two specific fields (see at least col.10, line 21-col.14, line 53 which discloses generating bills for different bills to customers. For different billers for the same customer two different bills/ bill images would be generated form the collected data and the two different bills would correlate to at least two specific fields such as biller's name, customer's account number, customer's name, account balance, etc.).

Regarding claims 6 and 7, Ensel discloses that the method of claim 5, wherein the separate images further comprises summary information and detailed information. (see at least col.10, lines 50, "*The structure and content of the **Summary file 210** and the **E-Bill file 215** varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location..... The E-Bill data residing in this file 215 contains the **detailed description** of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller).*". The information in summary file 210 and file 215 corresponds to the claimed summary information and detailed information which are included in the bill to be presented to the customer, see col.13, line 52-col.14, line 8).

Regarding claim 13, its limitations are closely parallel to the method claims 1-7 and is therefore, analyzed and rejected on the basis of same rationale. As regards the limitations selecting plurality of clients see col.8, lines 14-25, which discloses presenting bills to customers 80 and it would be inherent to select customers for presenting the bill as per the customer specified format.

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Regarding claim 16, Ensel discloses that the method of claim 13, wherein the defined bill format further comprises a corrected bill image (see col.15, lines 24-26, “ *spot check bills prior to publication; and provide full audit control over all add/change/delete activity.* ” . Note: checking bills and being able to execute add, change and delete activity corresponds to generating a corrected bill image)

Regarding claim 17, Ensel discloses that the method of claim 13, wherein producing the bill further comprises one or more of the following: presenting a bill image on a display device, printing a bill, sending a bill via email, and sending a bill via facsimile (see at least col.8, lines 14-25, “*regular paper mail ...e-mail ...*” and col.8, lines 56-62, “*Other existing channels include telephone, pagers...interactive cable television....facsimile....*”).

Regarding system claims 18-19, their limitations are closely parallel to the method claims 1-7, 13, and 16-17 and are therefore analyzed and rejected on the basis of same rationale. Also see FIGS. 1-6. The IIP 20 being capable of providing a billing control application through application server 240 (see Fig.2)and instructions for a bill having a predetermined format for a client (see at least col.6, line 11-col.10, line 2) . The client usage data is in Enrollment database 205 (see col.10, line 3-col.12, line 43. Also see col.16, line 60- col.17, line 40)

Regarding claim20, Ensel discloses that the system of claim 18, wherein the billing server application further comprises interactive and batch functionality facsimile (see at least col.8, lines 14-25, “*regular paper mail ...e-mail ...*” and col.8, lines 56-62, “*Other existing channels include telephone, pagers...interactive cable television....facsimile....*”. Note: presenting bills

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via paper mail or email represent batch functionality while presenting bills via interactive cable television represent interactive functionality.).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1 Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Siemens (EP 590332 A1).

Regarding claim 12, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Siemens discloses (see at least the "Abstract " and "Advantage", " *An internationally applicable system is used for a communication network between different countries and each country (A) has transit nodes to allow a conversion to be made between the source language and a neutral global language (GS). This can then be transmitted to a number of different countries and can be translated. The process is bidirectional. ADVANTAGE - Use of global language together with translation programs installed in each country provides reduction in processing in comparison with system in which country has to carry translation programs for all other countries, and reduces number of communication translation programs* "). In view of Siemens, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the bill and converting all

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correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide reduction in processing in comparison with system in which country has to carry translation programs for all other countries, and reduces number of communication translation programs as explicitly suggested in Siemens.

6.2 Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Mitra et al. (US 20010014878 A1), hereinafter, referred to as Mitra.

Regarding claim 14, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a closing bill. However, in the field of same endeavor, Mitra teaches producing a closing bill (see at least page 9, paragraph 0092, "..... *The controller 202 may also indicate that a **final bill** may be issued to the canceling buyer and if the buyer makes a final payment, the controller 202 will forward the payment to the unpaid sellers. Then, the controller 202 goes to step 1019. In step 1019, the controller 202 sends a **final bill** to the buyer for the shortfall and goes to step 1021. In step 1021, the controller 202 determines whether a final payment has been received from the canceling buyer.*". Note: In Mitra, Final bill corresponds to the claimed closing bill.). In view of Mitra, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a closing bill because it would enable the system to present final bills to the consumers when they close or cancel the accounts.

6.3 Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Logan et al. (US 20010009002 A1), hereinafter, referred to as Logan.

Regarding claim 15, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a duplicate bill. However, in

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the field of same endeavor, Logan teaches producing a duplicate bill (see at least page 8, paragraph 0096, *"....Post production activities may include, for example, storing a copy of a bill image as generated by each BPW 506 in the database for later access by a CSR on-screen in case a customer wishes to discuss an old or newly generated bill. Thus an archive database of customer bills is maintained within the system for some period of time so that images may be called up wherein the images will match the hard copies generated and mailed by the bill renderer."*. Note: In Mitra, storing a copy of a bill corresponds to producing a duplicate bill.). In view of Logan, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a duplicate bill copy because it would help the system for later access in case a customer wishes to discuss an old or newly generated bill as suggested in Logan. Also see page 12, paragraph 0141.

7. *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US 2002/0065772 A1 to Saliba et al., (see at least abstract) US Patent 6,418,467 B1 to Schweitzer et al. (see at least abstract), US Patent 6,292,789 B1 to Schutzer (see at least abstract), US Patent 6,282,552 B1 to Thompson et al. (see at least abstract), and US Patent 5,963,925 to Kolling et al. (see at least abstract) all disclose methods and systems providing particularized billing services.

(ii) JP 11105460A to Shimura discloses producing duplicate bills (see at least "Title " and " Advantage").

(iii) Dalton, Gregory, " E-Billa arrive"; Information week; April 19, 1999, Iss. 730; pg.18, 2 pgs, extracted from proquest database on Internet on 4/29/2004 discloses Electronic billing services being offered to billers and customers.

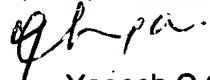
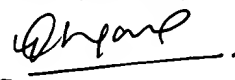
(iv) Press release, " Oracle announces Oracle Internet Bill & Pay 1.0, a Robust and Comprehensive Electronic Bill Presentment & Payment Solution"; PR Newswire; New York; Dec 2, 1998; pg.1, extracted from proquest database on Internet on 4/29/2004 discloses Electronic billing services being offered to billers and customers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 
Yogesh C Garg
Examiner
Art Unit 3625

YCG
April 27, 2004